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EXAMINER

DARROW, JUSTIN T

ART UNIT PAPER NUMBER

2132

DATE MAILED: 08/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/698,044

Applicant(s)

GINTER ET AL.

Examiner

Justin T. Darrow

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 91-134 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 91-126 is/are rejected.
- 7) ☒ Claim(s) 127-134 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,6,8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-134 have been presented for examination. Claims 1-90 have been canceled and new claims 91-134 have been added in a preliminary amendment filed 10/30/2000. Claims 91-134 have been examined.

***Priority***

2. Acknowledgment is made that the instant application is a continuation of Application No. 09/208,017, filed 12/09/1998, now U.S. Patent No. 6,253,193 B1, which is a continuation of Application No. 08/964,333, filed 11/04/1997, now U.S. Patent No. 5,982,891 A, which is a continuation of Application No. 08/388,107, filed 02/13/1995, now abandoned.

***Drawings***

3. The drawings filed on 10/30/2000 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. Formal drawings with corrections must be made in reply to this Office action. See 37 CFR 1.85(a).

***Specification***

4. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 91, 92, 99, 100, 103- 107, 109-118, and 120-124 are rejected under 35 U.S.C. 102(e) as being anticipated by Stefik et al., U.S. Patent No. 5,692,980 A.

As per claim 91, Stefik et al. depict a method comprising:

receiving a digital file (see column 7, lines 9-11; figure 1, steps 101 and 102; Repository 1 receiving a digital work from a creator);

storing the digital file in a first secure memory of a first device (see column 7, lines 9-11; figure 1, step 102; storing the digital work in Repository 1; see column 15, lines 45-67; column 16, lines 1-35; TABLE 2; where the repository is capable of various levels of security);

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storing information associated with the digital file in a secure database on the first device including at least one control (see column 7, lines 9-11; figure 1, step 102; storing usage rights and fees in Repository 1; see column 15, lines 45-67; column 16, lines 1-35; TABLE 2; where the repository is capable of various levels of security);

using a CPU of the first device, determining whether the digital file may be stored on a second device based on the at least one control (see column 7, lines 23-26; figure 1, step 105; Repository 1 checks the usage rights associated with the digital work to determine if the access to the digital work may be granted; see column 14, lines 13-17; figure 12, item 1201; where the processing element in Repository 1 provides usage rights transaction functions);

if the at least one control allows at least a portion of the digital file to be stored on a second device (see column 31, lines 59-62; figure 18, step 1809; if the copy count is less than the copies in use),

copying at least a portion of the digital file (see column 31, lines 61-62; figure 18, step 1810; incrementing the number of copies by the number of digital works requested);

transferring at least a portion of the digital file to a second device including a memory and an audio and/or video output (see column 36, lines 57-59; the server and requester read and write the blocks of data as requested by the player according to a transmission protocol; see column 36, lines 29-32; where the requester includes a speaker and display device and a memory);

storing the digital file in the memory of the second device (see column 14, lines 29-33; figure 12, item 1204; storing the associated content); and

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rendering the digital file through the output (see column 36, lines 59-60; the requester plays the work contents, using the player).

As per claim 92, Stefik et al. further point out:

the digital file including music (see column 36, lines 38-39; playing music from the digital work); and

playing music through the audio output (see column 36, lines 30-32; play the digital work through some kind of transducer, such as a speaker).

As per claim 99, Stefik et al. also describe:

transferring at least one control associated with the digital file (see column 18, lines 24-29; figure 14; the right is transferred with the digital work to indicate use or distribution privileges to the repository); and

storing the at least one control at the second device (see column 18, lines 28-33; figure 12, item 1203; descriptor tree storage storing the right of the digital work).

As per claim 100, Stefik et al. then embody:

that the information includes at least one budget control and at least one copy control (see column 18, lines 13-15; PRINT right to make 5 copies for \$10.00).

As per claim 103, Stefik et al. additionally describe:

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identifying the second device (see column 27, lines 36-38; a registration transaction to establish a secure channel between two repositories who know each other's identities); and

determining whether the first control allows transfer of the copied file to the second device (see column 31, lines 59-62; figure 18, step 1810; if the copy count is less than the copies in use, the transaction continues and the copies in use is incremented).

As per claim 104, Stefik et al. moreover specify:

that the digital file is transferred to the second device in an encrypted state (see column 29, lines 2-5; encrypting messages with a session key pair); and

decrypting the digital file prior to the rendering step (see column 29, lines 12-14; decrypting further communications during the session).

As per claim 105, Stefik et al. then discuss:

that the second device includes a tamper-resistant housing (see column 12, lines 51-56; higher security classes of repositories may have sensors that detect when tampering is attempted on their secure cases).

As per claim 106, Stefik et al. next describe:

that the memory of the second device comprises random access memory (see column 14, lines 22-24; figure 12, item 1202; processor memory is Random Access Memories (RAM).

As per claim 107, Stefik et al. further elaborate:

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nonvolatile random access memory (see column 14, lines 22-24; figure 12, item 1202; Read Only Memories (ROM)).

As per claim 109, Stefik et al. additionally show:

that the first device includes a secure processing unit (see column 14, lines 20-22; figure 12, item 1201; the processor may be microprocessor).

As per claim 110, Stefik et al. then describe:

that the second device comprises a speaker (see column 36, lines 30-33; play a digital work through a speaker).

As per claim 111, Stefik et al. illustrate a method comprising:

receiving a digital file at a first device (see column 7, lines 49-51; figure 2, item 201; repository is an exchange medium for digital works);

establishing communication between the first device and a clearinghouse located at a location remote from the first device (see column 7, lines 51-55; figure 2, items 201 and 202; the repository may communicate with an authorization repository);

the first device obtaining authorization information from the clearinghouse (see column 7, lines 57-59; figure 2, items 201 and 202; communication may occur to obtain an authorization); and



the first device using the authorization information to gain access to or make at least one use of the first digital file (see column 7, lines 59-61; the authorization is a digital certificate required to gain access to the digital work);

storing the first digital file in a memory of the first device (see column 7, lines 9-11; figure 1, step 102; storing the digital work in Repository 1);

using at least a first control to determine whether the first digital file may be copied and stored on a second device (see column 7, lines 23-26; figure 1, step 105; Repository 1 checks the usage rights associated with the digital work to determine if the access to the digital work may be granted);

if the at least one control allows at least a portion of the digital file to be copied and stored on a second device (see column 31, lines 59-62; figure 18, step 1809; if the copy count is less than the copies in use),

copying at least a portion of the first digital file (see column 31, lines 61-62; figure 18, step 1810; incrementing the number of copies by the number of digital works requested);

transferring at least a portion of the first digital file to a second device including a memory and an audio and/or video output (see column 36, lines 57-59; the server and requester read and write the blocks of data as requested by the player according to a transmission protocol; see column 36, lines 29-32; where the requester includes a speaker and display device and a memory);

storing the first digital file in the memory of the second device (see column 14, lines 29-33; figure 12, item 1204; storing the associated content); and

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rendering the first digital file through the output (see column 36, lines 59-60; the requester plays the work contents, using the player).

As per claim 112, Stefik et al. further describe:

the authorization information including at least one key (see column 28, lines 64-67; repositories exchange session keys to be used in all communications); and

using the at least one key to decrypt at least a portion of the first digital file (see column 29, lines 12-14; decrypting further communications during the session).

As per claim 113, Stefik et al. additionally describe:

determining whether the first control allows transfer of the copied file to the second device (see column 31, lines 59-62; figure 18, step 1810; if the copy count is less than the copies in use, the transaction continues and the copies in use is incremented) based on identifying the second device (see column 27, lines 36-38; a registration transaction to establish a secure channel between two repositories who know each other's identities).

As per claim 114, Stefik et al. then point out:

The first control authorizes or fails to authorize the transfer to the second device based at least in part on the identification information (see column 28, lines 53-57; figure 16, step 1612; repository checks that the names of the two repositories are correct, where if a test fails, the transaction terminates).

As per claim 115, Stefik et al. moreover specify:  
that the first digital file is transferred to the second device in an encrypted state (see column 29, lines 2-5; encrypting messages with a session key pair); and  
decrypting the digital file prior to the rendering step (see column 29, lines 12-14; decrypting further communications during the session).

As per claim 116, Stefik et al. then discuss:  
that the second device includes a tamper-resistant housing (see column 12, lines 51-56; higher security classes of repositories may have sensors that detect when tampering is attempted on their secure cases).

As per claim 117, Stefik et al. next describe:  
that the memory of the second device comprises random access memory (see column 14, lines 22-24; figure 12, item 1202; processor memory is Random Access Memories (RAM).

As per claim 118, Stefik et al. further elaborate:  
nonvolatile random access memory (see column 14, lines 22-24; figure 12, item 1202; Read Only Memories (ROM)).

As per claim 120, Stefik et al. additionally show:  
that the first device includes a secure processing unit (see column 14, lines 20-22; figure 12, item 1201; the processor may be microprocessor).

As per claim 121, Stefik et al. then describe:

that the second device comprises a speaker (see column 36, lines 30-33; play a digital work through a speaker).

As per claim 122, Stefik et al. illustrate a method comprising:

receiving a digital file at a first device (see column 7, lines 49-51; figure 2, item 201; repository is an exchange medium for digital works);

establishing communication between the first device and a first clearinghouse located at a location remote from the first device (see column 7, lines 51-55; figure 2, items 201 and 202; the repository may communicate with an authorization repository);

the first device obtaining authorization information from the first clearinghouse (see column 7, lines 57-59; figure 2, items 201 and 202; communication may occur to obtain an authorization) and using the authorization information to gain access to or make at least one use of the first digital file (see column 7, lines 59-61; the authorization is a digital certificate required to gain access to the digital work);

storing the first digital file in a memory of the first device (see column 7, lines 9-11; figure 1, step 102; storing the digital work in Repository 1);

receiving a second digital file at the first digital device (see column 7, lines 48-49; figure 2, item 201; repository will be initiating request to access multiple digital works);

establishing communication between the first device and a second clearinghouse located at a location remote from the first device (see column 7, lines 51-55; figure 2, items 201 and 202; the repository may communicate with a plurality of authorization repositories);

the first device obtaining information from the second clearinghouse (see column 7, lines 57-59; figure 2, items 201 and 202; communication may occur to obtain an authorization) and using the authorization information to gain access to or make at least one use of the second digital file (see column 7, lines 59-61; the authorization is a digital certificate required to gain access to the digital work);

using at least a first control to determine whether the first digital file may be copied and stored on a second device (see column 7, lines 23-26; figure 1, step 105; Repository 1 checks the usage rights associated with the digital work to determine if the access to the digital work may be granted);

if the first control allows at least a portion of the digital file to be copied and stored on a second device (see column 31, lines 59-62; figure 18, step 1809; if the copy count is less than the copies in use),

copying at least a portion of the first digital file (see column 31, lines 61-62; figure 18, step 1810; incrementing the number of copies by the number of digital works requested);

transferring at least a portion of the first digital file to a second device including a memory and an audio and/or video output (see column 36, lines 57-59; the server and requester read and write the blocks of data as requested by the player according to a transmission protocol;

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see column 36, lines 29-32; where the requester includes a speaker and display device and a memory);

storing the first digital file in the memory of the second device (see column 14, lines 29-33; figure 12, item 1204; storing the associated content); and

using at least a second control to determine whether the second digital file may be copied and stored on a second device (see column 7, lines 48-49; figure 2, item 201; repository will be initiating request to access multiple digital works; see column 7, lines 23-26; figure 1, step 105; Repository 1 checks the usage rights associated with the digital work to determine if the access to the digital work may be granted; see column 7, lines 8-11; figure 1, step 102; where each digital work has attached usage rights and fees);

if the second control allows at least a portion of the digital file to be copied and stored on a second device (see column 31, lines 59-62; figure 18, step 1809; if the copy count is less than the copies in use),

copying at least a portion of the second digital file (see column 31, lines 61-62; figure 18, step 1810; incrementing the number of copies by the number of digital works requested);

transferring the second digital file portion to the second device (see column 36, lines 57-59; the server and requester read and write the blocks of data as requested by the player according to a transmission protocol);

storing the second digital file in the memory of the second device while the first digital file portion is also stored in the memory (see column 8, lines 41-46; figure 4, item 402;

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printer repository contains a copy of a digital work which remains until it is printed or remains permanently and billed as used ); and

rendering the first or second digital file through the output (see column 8, lines 41-43; figure 4, item 402; printer repository contains a copy of a digital work which remains until it is printed; see column 37, line 32; the requester prints the work contents, using the printer).

As per claim 123, Stefik et al. further embody the first clearinghouse and second clearinghouse are the same clearinghouse (see column 7, lines 48-51; in requester mode, the repository will be initiating requests to access digital works from an authorization repository).

As per claim 124, Stefik et al. additionally suggest that the first clearinghouse and the second clearinghouse are different clearinghouses (see column 7, lines 51-55; the repository may communicate with a plurality of authorization repositories).

7. Claims 111-115 and 120 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsevdos et al., U.S. Patent No. 5,734,719 A.

As per claim 111, Tsevdos et al. illustrate a method comprising:

receiving a digital file at a first device (see column 9, lines 19-23; figure 1, items 126 and 132; system that is suited to obtain and serve video or audio data);

establishing communication between the first device and a clearinghouse located at a location remote from the first device (see column 18, lines 28-33; figure 13, items 1304, 1324, and 1312; sending an op\_grant message to the Authorization Server);

the first device obtaining authorization information from the clearinghouse (see column 18, lines 57-67; figure 13, items 1304 and 1314; if an op\_approved message is received, sending an op\_make message); and

the first device using the authorization information to gain access to or make at least one use of the first digital file (see column 19, lines 12-15; figure 13, item 1314; when the op\_make message, the listed items can be manufactured);

storing the first digital file in a memory of the first device (see column 9, lines 19-23; figure 1, items 126 and 132; system that is suited to store and serve video or audio data);

using at least a first control to determine whether the first digital file may be copied and stored on a second device (see column 18, lines 38-45; criteria for denying authorization includes release data later than today's date);

if the at least one control allows at least a portion of the digital file to be copied and stored on a second device (see column 18, lines 57-67; figure 13, items 1304 and 1314; if an op\_approved message is received, sending an op\_make message),

copying at least a portion of the first digital file (see column 19, lines 34-36; figure 13, items 1314, 1324, and 1328; Data Server copying the material data);

transferring at least a portion of the first digital file to a second device including a memory and an audio and/or video output (see column 19, lines 34-36; figure 13, items 1314,



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1324, and 1328; transferring material data; column 19, lines 31-33; figure 13, item 1322; a technician viewing the material data, identifying the material data being transferred);

storing the first digital file in the memory of the second device (see column 19, lines 37-44; figure 13, item 1316; storing the material data for decryption and decompression processing); and

rendering the first digital file through the output (see column 19, lines 34-36; figure 13, items 1314, 1322, and 1328; printing the viewed material data).

As per claim 112, Tsevdos et al. further point out:

the authorization information including at least one key (see column 19, lines 42-44; the cryptographic key needed for the decryption may be contained in the original op\_approve message from the Authorization Server); and

using the at least one key to decrypt at least a portion of the first digital file (see column 19, lines 38-44; a decryption step is likely necessary with the cryptographic key needed for decryption).

As per claim 113, Tsevdos et al. additionally state:

that the determining step is based at least in part on identification information regarding the second device (see column 18, lines 38-45; criteria for denying or approving authorization may include: a particular store's credit rating; and certain retail outlets may want to prohibit sale of certain works).

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As per claim 114, Tsevdos et al. then suggest:

that the first control authorizes or fails to authorize the transfer to the second device based at least in part on the identification information (see column 18, lines 38-45; criteria for denying authorization may include: a particular store's credit rating; and certain retail outlets may want to prohibit sale of certain works).

As per claim 115, Tsevdos et al. also discuss:

the first digital file portion is transferred to the second device in an encrypted state (see column 19, lines 37-42; the data being transferred may be encrypted); and

decrypting the first digital file prior to the rendering step (see column 19, lines 38-42; before the data is actually routed to the manufacturing machine, a decryption step is likely necessary).

As per claim 120, Tsevdos et al. moreover suggest:

that the first device includes a secure processing unit (see column 14, lines 31-39; figure 1, items 132 and 130; data may be encrypted at the data capture unit where each cryptographic key is protected in the royalty accounting unit).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 93-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 5,692,980 A as applied to claim 92 above, and further in view of Tsevdos et al., U.S. Patent No. 5,734,719 A.

As per claim 93, Stefik et al. disclose the method of claim 92. However, they do not explicitly teach receiving the digital file on a video disk. Tsevdos et al. describe :

receiving the digital file on a video disk (see column 8, lines 53-66 ; figure 1, items 126 and 132; a master site including a data capture process and data server with optical jukeboxes).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the method of Stefik et al. with the receiving the digital file on a video disk of Tsevdos et al. to allow a customer to preview content subject matter available on different media (see column 3, lines 55-64).

As per claim 94, Tsevdos et al. further explain:

receiving the information on the video disk (see column 8, lines 53-66 ; figure 1, items 126 and 132; a master site including a data capture process and data server with optical jukeboxes; column 18, lines 38-42; where the criteria for approving or denying authorization includes a release data later than today's date).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the method of Stefik et al. with the receiving the digital file on a video disk of Tsevdos et al. to allow the retailer to comply with the challenge of

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identifying what quantities are marketable over what period of time for that artist any any number of other artists and labels (see column 2, lines 6-8).

As per claim 95, Tsevdos et al. additionally describe:

that the information received on the video disk includes at least one control governing the use that may be made of at least one digital file stored on the video disk (see column 8, lines 53-66; figure 1, items 126 and 132; a master site including a data capture process and data server with optical jukeboxes; column 18, lines 38-42; where the criteria for approving or denying authorization includes a release data later than today's date).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the method of Stefik et al. with the control information on the video disk of Tsevdos et al. to allow the retailer to comply with the challenge of identifying what quantities are marketable over what period of time for that artist any any number of other artists and labels (see column 2, lines 6-8).

As per claim 96, Tsevdos et al. moreover specify:

that the first use comprises a use that may be made of such digital file at the first device (see column 18, lines 66-67; when the op\_approved message has been received; see column 19, lines 12-30; which gives rise to the op\_make message which initiates the copying and transferring the content data).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the method of Stefik et al. with the use that may be

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made of such digital file at the first device of Tsevdos et al. to allow the retailer to comply with the challenge of identifying what quantities are marketable over what period of time for that artist any any number of other artists and labels (see column 2, lines 6-8).

As per claim 97, Tsevdos et al. further elaborate:

at least making of at least one copy of the digital file at the first device and transferring the copy to a second device (see column 18, lines 66-67; when the op\_approved message has been received; see column 19, lines 12-30; which gives rise to the op\_make message which initiates the copying and transferring the content data).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the method of Stefik et al. with the at least making of at least one copy of the digital file at the first device and transferring the copy to a second device of Tsevdos et al. to allow the retailer to comply with the challenge of identifying what quantities are marketable over what period of time for that artist any any number of other artists and labels (see column 2, lines 6-8).

10. Claim 98 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 5,692,980 A as applied to claim 92 above, and further in view of Von Kohorn et al., U.S. Patent No. 5,759,101 A.

Stefik et al. disclose the method of claim 92. However, they do not explicitly teach that the second device is portable. Von Kohorn et al. describe:

That the second device is portable (see column 55, lines 18-27; figure 6, item 220; the recording/playback apparatus could be combined with a response unit in the manner of a small, portable unitary structure).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the method of Stefik et al. with the portable device of Von Kohorn et al. to allow a person to use subject matter privately at a location of convenience (see column 55, lines 18-23).

11. Claims 101 and 102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 5,692,980 A as applied to claim 91 above, and further in view of Tsevdos et al., U.S. Patent No. 5,734,719 A.

As per claim 101, Stefik et al. disclose the method of claim 91. However, they do not explicitly teach receiving the digital file on a video disk. Tsevdos et al. describe :

receiving the digital file (see column 8, lines 53-66 ; figure 1, items 126 and 132; a master site including a data capture process and data server with optical jukeboxes) and the information on a video disk (see column 8, lines 53-66 ; figure 1, items 126 and 132; a master site including a data capture process and data server with optical jukeboxes; column 18, lines 38-42; where the criteria for approving or denying authorization includes a release data later than today's date).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the method of Stefik et al. with the receiving the digital

file and information on a video disk of Tsevdos et al. to allow a customer to preview content subject matter available on different media (see column 3, lines 55-64).

As per claim 102, Tsevdos et al. further point out:

budget information relating to permitted uses of the digital file (see column 18, lines 38-48; the criteria for approving or denying authorization may include: a particular store's credit rating that may be exceeded by the transaction).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the method of Stefik et al. with the budget information relating to permitted uses of the digital file of Tsevdos et al. to exploit the economic opportunities available from the analysis of such data (see column 4, lines 22-28).

12. Claims 108 and 119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 5,692,980 A as applied to claims 107 and 118 above, respectively, and further in view of Von Kohorn et al., U.S. Patent No. 5,759,101 A.

Stefik et al. disclose the methods of claim 107 and 119. However, they do not explicitly teach that the second device includes at least one battery. Von Kohorn et al. describe:

that the second device is portable (see column 55, lines 18-27; figure 6, item 220; the recording/playback apparatus could be combined with a response unit in the manner of a small, portable unitary structure).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the method of Stefik et al. with the portable device of Von Kohorn et al. to allow a person to use subject matter privately at a location of convenience (see column 55, lines 18-23).

Neither Stefik et al. nor Von Kohorn et al. teach the battery in the second device. Official notice is taken that the second device including a battery is old and well known in the computer art. It would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the method of Stefik et al. with the portable unitary device of Von Kohorn et al. incorporating a battery to allow a person to use subject matter privately at a location of convenience (see column 55, lines 18-23).

13. Claims 125 and 126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 5,692,980 A as applied to claim 122 above, and further in view of Tsevdos et al., U.S. Patent No. 5,734,719 A.

As per claim 125, Stefik et al. disclose the method of claim 122. However, they do not explicitly teach receiving the digital file on a video disk. Tsevdos et al. illustrate:

receiving the first digital file on a first portable memory and the second digital file on a second portable memory, different from the first portable memory (see column 8, lines 53-66 ; figure 1, items 126 and 132; a master site including a data capture process and data server with optical jukeboxes with multiple disks).



Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the method of Stefik et al. with the receiving the digital files on different portable memories of Tsevdos et al. to allow a customer to preview content subject matter available on different media (see column 3, lines 55-64).

As per claim 126, Tsevdos et al. further elaborate:

That the first portable and the portable memory are disks memory (see column 8, lines 53-66; figure 1, items 126 and 132; a master site including a data capture process and data server with optical jukeboxes with multiple disks).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the method of Stefik et al. with the receiving the digital files on different disks of Tsevdos et al. to allow a customer to preview content subject matter available on different media (see column 3, lines 55-64).

#### ***Allowable Subject Matter***

14. Claims 127-134 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter:

Claims 127-134 are drawn to a method. Stefik et al. in view of Tsevdos et al. disclose a similar method. Although Tsevdos et al. describe streaming to a CD writer, tapewriter, color printer, or alternate recorder, decrypted and decompressed data (see column 14, lines 39-46;

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figure 12, items 104, 1210, 1212, 1214, 1202, 1204, 1206, and 1208), they neither show nor motivate, prior to receiving the second digital file at the first device, storing the first digital file in a second secure container, including the second digital file and at least one control governing at least one aspect of use of or access to the second digital file while the second file is contained in the second secure container and being stored on the second portable memory. This composite limitation explicitly recited in intervening claim 127 renders claims 127-134 to have allowable subject matter.

### ***Telephone Inquiry Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin T. Darrow whose telephone number is (703) 305-3872 and whose electronic mail address is [justin.darrow@uspto.gov](mailto:justin.darrow@uspto.gov). The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón, Jr., can be reached at (703) 305-1830.

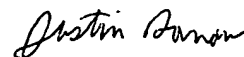
The fax numbers for Formal or Official faxes to Technology Center 2100 are (703) 305-0040 and (703) 746-7239. Draft or Informal faxes for this Art Unit can also be submitted to (703) 746-7240. In order for a formal paper transmitted by fax to be entered into the application file, the paper and/or fax cover sheet must be signed by a representative for the applicant. Faxed formal papers for application file entry, such as amendments adding claims, extensions of time, and statutory disclaimers for which fees must be charged before entry, must be transmitted with an authorization to charge a deposit account to cover such fees. It is also recommended that the

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cover sheet for the fax of a formal paper have printed "**OFFICIAL FAX**". Formal papers transmitted by fax usually require three business days for entry into the application file and consideration by the examiner. Formal or Official faxes including amendments after final rejection (37 CFR 1.116) should be submitted to (703) 746-7238 for expedited entry into the application file. It is further recommended that the cover sheet for the fax containing an amendment after final rejection have printed not only "**OFFICIAL FAX**" but also "**AMENDMENT AFTER FINAL**".

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

August 4, 2003



**JUSTIN T. DARROW  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 2100**